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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,486	07/25/2003	Hendrik F. Hamann	FIS920020170US1	1485

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INTERNATIONAL BUSINESS MACHINES CORPORATION
DEPT. 18G
BLDG. 300-482
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HOPEWELL JUNCTION, NY 12533

EXAMINER

ALANKO, ANITA KAREN

ART UNIT	PAPER NUMBER
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1765

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,486

Applicant(s)

HAMANN ET AL.

Examiner

Anita K. Alanko

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a): In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/23/05 amdt.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. .
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date .
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on September 23, 2005 is acknowledged.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Derderian et al (US 6,245,191 B1) in view of Shur et al (US 2004/0186459 A1).

Derderian discloses an apparatus adapted to alter a feature of a substrate, said apparatus comprising:

(a) a probe 26 having a plurality of channels 32,34,36,38,40 through said probe to exit at an apex of said probe (Fig. 8),

(b) means for maneuvering said apex of said probe to a site proximate to a target feature 20,30 to be altered (e.g., X-Y pen plotter technology (col.10, lines 20-22); an example target feature is an etched trench, col.9, lines 62-65), and

(c) a source of a first chemical coupled to a first channel 32 for delivery of said chemical through said apex, and

(d) either a source of a second chemical coupled to a second channel 34 for delivery through said apex or a source of suction 36 coupled to a second channel for delivery through said apex.

Derderian fails to disclose the diameter of the apex of the probe. However, Derderian discloses to use small gauge tubes such as nanotubes (col.5, lines 15-16), and that a desired number of nanotubes may be used, depending on the specific nature of the etch to be accomplished (col.10, lines 14-19). Derderian is directed to forming trenches (col.9, lines 62-65), for example for use in semiconductor devices (col.1, lines 9-28), for which micron-sized features are conventional.

Shur teaches that nanotubes for fluid delivery are typically on the order of 1-30 nm in diameter ([0038]). Figure 8 of Derderian depicts five nanotubes, which would suggest an apex of about at least greater than 150 nm, 0.15 microns, if each nanotube is 30 nm in diameter. Since trenches are typically formed on the micron size, and the area of the apex is close in value to the size of the trench, Derderian suggests to use probes with an apex on the micron scale.

It would have been obvious to one with ordinary skill in the art to use the number of nanotubes to achieve the cited apex because Derderian teaches to use the number desired according to the dimension sought to form features of the desired dimensions, for example since

micron-sized features are useful in semiconductor devices, a probe with a micron-sized apex would be useful.

As to claim 2, Derderian discloses that the first and second chemicals etch to form a trench, and they are inherently mixed. Further, the manner in which an apparatus operates is not germane to the issue of patentability of the apparatus itself. *Ex parte Wikdahl* 10 USPQ 2d 1546, 1548 (BPAI 1989); *Ex parte McCullough* 7 USPQ 2d 1889,1891 (BPAI 1988); *In re Finsterwalder* 168 USPQ 530 (CCPA 1971); *In re Casey* 152 USPQ 235, 238 (CCPA 1967).

As to claim 3, the apparatus of Derderian is capable of providing diluting fluids. Further, the manner in which an apparatus operates is not germane to the issue of patentability of the apparatus itself. *Ex parte Wikdahl* 10 USPQ 2d 1546, 1548 (BPAI 1989); *Ex parte McCullough* 7 USPQ 2d 1889,1891 (BPAI 1988); *In re Finsterwalder* 168 USPQ 530 (CCPA 1971); *In re Casey* 152 USPQ 235, 238 (CCPA 1967).

As to claims 4-6, Derderian discloses that the second channel 36 is coupled to a source of suction (col.8, line 10), said suction being adapted to remove hot effluent from a reaction at said site to spatially confine an effect of said reaction (to control the footprint, col.8, lines 14-17).

As to claims 7-8, Derderian discloses that the channels are arranged parallel and concentrically to each other in said probe (Fig.8).

Response to Amendment

The objection to the specification and the rejections under 35 USC 112 and 102 are withdrawn. The specification now clearly links the means for maneuvering to an apparatus for the positioning of a scanned probe microscope ([0020]). The rejections over the prior art are

withdrawn since Yuasa and JP 09-027482 (Appl. No. JP 07-197997) do not disclose or suggest an apex having a diameter of about 0.1 to 3 microns. However this limitation is suggested by Derderian and Shur, and the claims are now newly rejected under 35 USC 103 over Derderian in view of Shur.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita K. Alanko whose telephone number is 571-272-1458. The examiner can normally be reached on Mon-Fri until 2:30 pm (Wed until 11:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571-272-1465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anita K. Alanko

Anita K Alanko
Primary Examiner
Art Unit 1765